

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
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Kevin J. Zilka et al.) Art Unit: 3689
)
Application No. 10/661,878) Examiner: Ruhl, Dennis William
)
Filed: 09/11/2003) Atty. Docket No. SVIPGP002B
)
For: SYSTEM, METHOD AND COMPUTER) Date: 10/27/2008
PROGRAM PRODUCT FOR)
COLLECTING STRATEGIC PATENT)
DATA ASSOCIATED WITH AN)
IDENTIFIER)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

REPLY BRIEF (37 C.F.R. § 41.37)

This Reply Brief is being filed within two (2) months of the mailing of the Examiner's Answer mailed on 08/25/2008.

Following is an issue-by-issue reply to the Examiner's Answer.

Issue # 1:

The Examiner has rejected Claim 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Group #1: Claims 1-2, 4-13, 18-20 and 44-45

It should be strongly noted that the excerpts cited below are set forth for illustrative purposes for purpose of providing at least one exemplary embodiment of the cited claim language. The claim language should not be construed as being limited to such exemplary excerpts in any manner whatsoever.

Specifically, the Examiner has argued the following:

Applicant has amended the independent claims to include the limitation of displaying statistics regarding a number of the patents of the set in each category of technology *in a first interface*, displaying first additional information associated with at least a portion of the patents of the set *in a second interface separate from the first interface* upon the selection of an icon *positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second*.

displaying second additional information associated with at least one of the patents of the list *in a third interface separate from the first interface and the second interface* upon the selection of an additional icon *positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface*

The Examiner request that the applicant direct the Examiner to where there is support for the newly added limitations.

In response, appellant draws the Examiner's attention to Figures 13, 15-16 and the quoted excerpt from page 29, lines 22-24; page 32, lines 8-25; and page 33, lines 6-14.

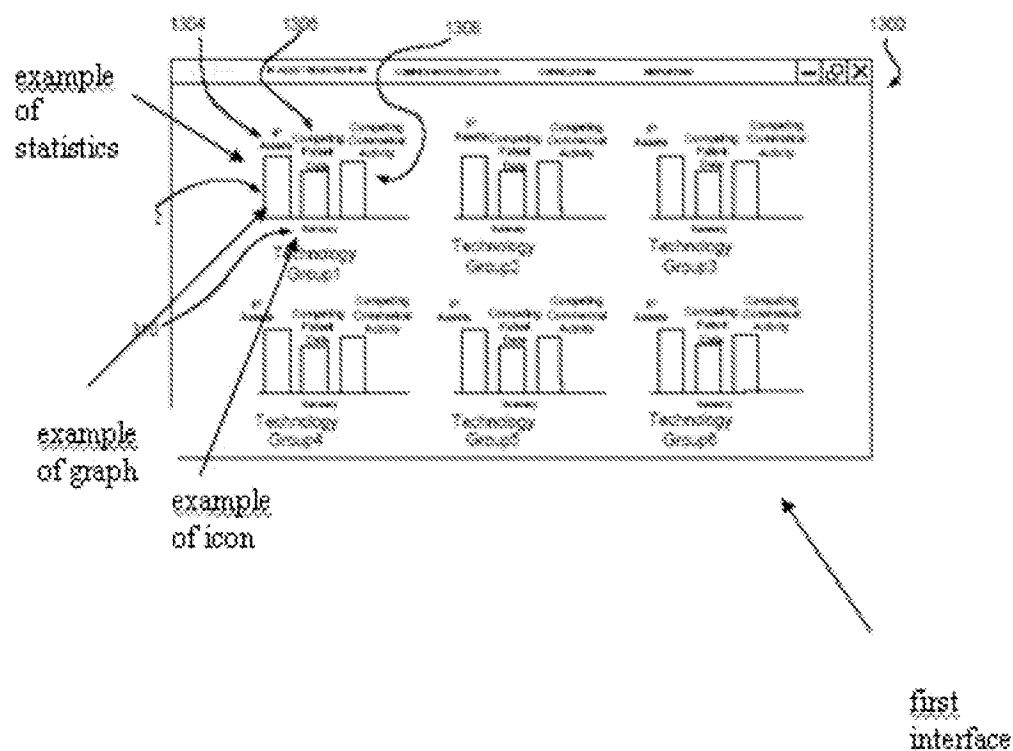


Figure 13

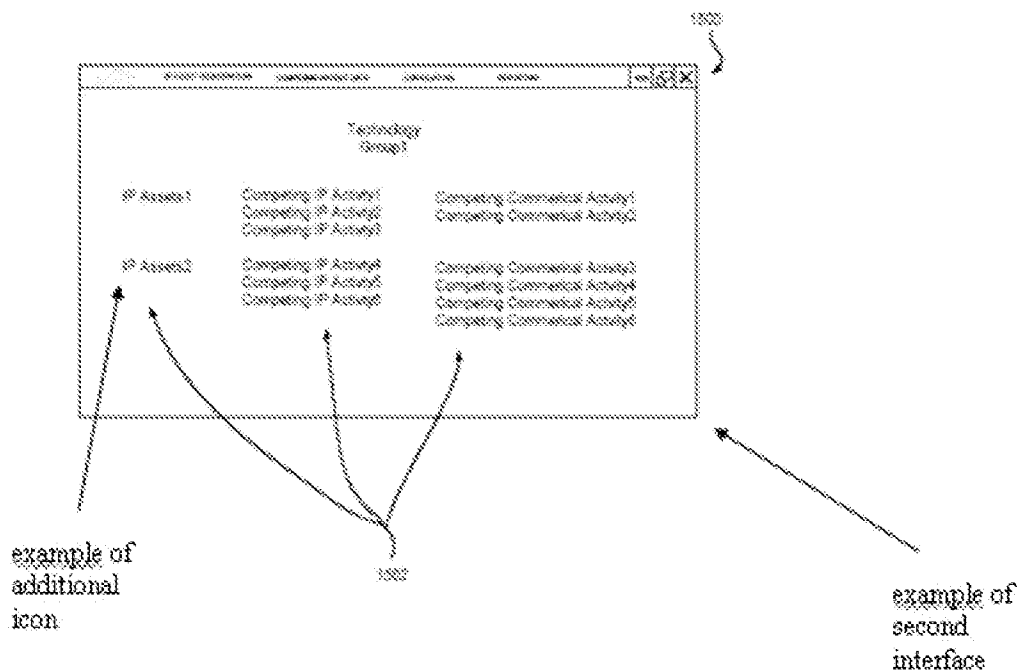


Figure 15

"Figure 15 illustrates an exemplary summary report 1500, in accordance with one embodiment. Such report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of Figure 13. In the alternative, such page may be generated in utilizing the report definition interface 1200 by selecting a particular technology category via pull-down window 1204, selecting all of the intellectual property identifiers via pull-down window 1202, and selecting a summary format type. Of course, the summary report 1500 may be generated in any desired manner." (emphasis added)

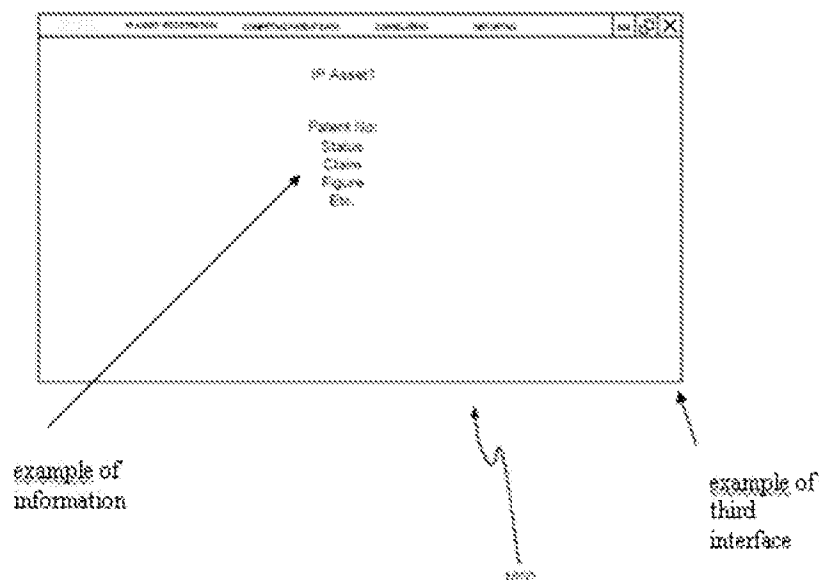


Figure 16

“In particular, upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented. Figure 16 illustrates an exemplary intellectual property details report 1600, in accordance with one embodiment. As shown, a patent number, status, exemplary claim and figure, etc. may be provided in such report. It should be noted that such intellectual property details report 1600 may also be generated directly utilizing the report definition interface 1200 by selecting a particular intellectual property identifiers via pull-down window 1202, and selecting a details format type.” (emphasis added)

“As shown, the summary report 1500 lists each of the intellectual property identifiers, each competing patent, and each instance of competing activity associated with the appropriate technology category. For reasons that will soon become apparent, each item in the lists 1502 may include a link to an additional page with more information.

In an alternate embodiment, an intellectual property identifier icon, competing patent icon, or a competing activity documentation icon may be selected separately.” (emphasis added)

“It should be noted that the electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by **drilling down** into selected areas.” (emphasis added)

Thus, in view of the experts provided above, appellant respectfully asserts that Claims 1-2, 4-13, 18-20 and 44-45 comply with the written description requirement under 35 U.S.C. 112, first paragraph.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

Thus, while applicant's disclosure discloses that selection of one of the patents may product specific information regarding such patent, that the electronic version of the report may include interactive feature, a graphical user interface (GUI) which is equipped for reporting on IP management, that the user may be allowed to select a summary icon on the GUI wherein such icon may act as a link to another page which sets forth additional information, that a summary report may be displayed in response to the selection of the summary icon of one of the technology categories or that the page may be generated by selecting a pull-down window, and that the summary report may be generated in any desired manner, applicant's disclosure does not disclose displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second, displaying second additional information

associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface. At most applicant discloses that applicant may be allowed to select a summary icon on the GUI, such icon may act as a link to another page which sets forth additional information and that the summary report lists each of the intellectual property identifiers, each competing patent, etc. and that each item in the lists may include links to an additional page. Applicant also discloses that upon a user selecting one of the intellectual property identifiers, more information relating to the property may be presented. At most, an additional page or information is presented. However, there is no disclosure that the page is separate for the first of second information. Moreover, a page is not another interface or GUI.

Appellant respectfully disagrees and again notes that the above excerpts clearly disclose that the “report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of Figure 13” (emphasis added), and that “upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented” where “Figure 16 illustrates an exemplary intellectual property details report 1600, in accordance with one embodiment” (emphasis added). Appellant further notes that the interface 1300, the report 1500, and the intellectual property details report 1600 are all distinctly shown in Figures 13, 15, and 16, respectively.

Additionally, appellant again notes that the above excerpts further teach that “[i]n an alternate embodiment, an intellectual property identifier icon, competing patent icon, or a competing activity documentation icon may be selected separately” (emphasis added), and that “the electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by drilling down into selected areas” (emphasis added).

Further, appellant disagrees with the Examiner's assertion that "a page is not another interface or GUI." For example, appellant draws the Examiner's attention to page 31, line 24, which discloses an "exemplary **graphical user interface 1300** of **Figure 13**" (emphasis added), and page 32, lines 17-21, which teach that "the summary report **1500** lists each of the intellectual property identifiers, each competing patent, and each instance of competing activity associated with the appropriate technology category" and that "each item in the lists **1502** may **include a link to an additional page** with more information" (emphasis added). Appellant again notes that the interface 1300, the report 1500, and the intellectual property details report 1600 are all distinctly shown in Figures 13, 15, and 16, respectively.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

The Appellant has referred to figure 13 which is disclosed as being a graphical user interface 1300. The report shown in figure 15 is not disclosed as being a separate interface from interface 1300, it is just disclosed as being another page.

Applicant seems to be arguing that because figure 13 is called an interface that any other pages can also be called interfaces. The specification as originally filed did not use language that called each individual page a separate interface from each other and applicant's argument is not taken as persuasive. The displaying of an additional page is not taken as constituting more than one interface that is separate from the others. This does not seem to be supported by the original disclosure. The examiner does not believe that a separate page is considered to be a separate interface (GUI) as has been argued.

Appellant respectfully disagrees and again notes that the above excerpts clearly disclose that the "report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of **Figure 13**" (emphasis added), and that "upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented" where "**Figure 16 illustrates**

an exemplary intellectual property details report 1600, in accordance with one embodiment,” where “the electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by **drilling down into selected areas**” (emphasis added). Appellant further notes that the interface 1300, the report 1500, and the intellectual property details report 1600 are all distinctly shown in Figures 13, 15, and 16, respectively.

Thus, in view of the excerpts provided above, appellant respectfully asserts that Claims 1-2, 4-13, 18-20 and 44-45 comply with the written description requirement under 35 U.S.C. 112, first paragraph.

Issue # 2:

The Examiner has rejected Claims 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Group #1: Claims 1-2, 4, 7, 10, 11, 13, 18-20, and 44-45

Specifically, the Examiner has argued the following:

The body of the claims have the following step:

storing the manually selected file in association with the at least one identifier by providing *a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier.*

First, it is not clear what applicant defines as a file. Second, what does the applicant mean by providing a correspondence between the file and the identifier. What is the applicant identifying as an identifier. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

This same step has the following language:

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus *associating* the manually selected file with the at least one identifier, thus associating the manually selected file with the at least one identifier, *wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents*

What does the applicant mean by associating the file with the identifier?

In response, appellant relies on the plain and ordinary meaning of “file” and “identifier,” “correspondence,” “associated,” etc.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the 112,2nd paragraph rejection, the argument is not persuasive, with the exception that with respect to the limitation of a "file" and what that means as well as what is meant by "accessible", those portions of the rejection has been withdrawn and overcome in view of the arguments.

With respect to the issue of what is meant by the language of "providing a correspondence between the file and the at least one identifier", the appellant has not explained or provided any argument with respect to what this language means. The same seems true of for the issue regarding the identifier and what scope this term has. Applicant seems to only argued that the appellant "relies on the plain and ordinary meaning of "file" and "identifier", "correspondence", associated, etc.". This is not addressing the issue that was set forth by the examiner. The appellant has not even provided the "plain and ordinary meaning" of these terms so it is not clear what the position of the appellant is. The 112 rejection for these issues will be maintained due to a lack of a persuasive traversal.

Appellant respectfully disagrees and notes that it appears that the Examiner has taken issue with many terms that may be found in the dictionary. Additionally, appellant again notes that the above claim language, including "identifier," "correspondence," and "associated," is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, etc.

Further, the Examiner has argued:

The applicant has a step of storing the manually entered notes in association with at least one identifier and then a step of allowing a selection of a file. Then the applicant states that a manually selected first file is associated with a first identifier corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

First, is the first identifier the same identifier that the notes were stored with? Secondly, the applicant states that the notes are stored in association with at least one identifier, requiring only one identifier. If there is only one identifier, how can there be a first and second identifier. Are these in addition to the identifier stored with the notes? Furthermore, the applicant has a step of allowing the manual selection of a file. If there is only one file, how can there be a first file and a second file?

Regarding the first inquiry, the claim language is purposefully drafted in a broad manner so not to be limited to a scenario where “the first identifier is the same identifier that the notes were stored with.” In other words, it may or may not be and to specify one way or another would be unduly limiting to the claims.

Regarding the second inquiry, the claims do not require “only one identifier,” but rather “at least one.”

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

it seems that the claim recites "at least one identifier" and "a first identifier" and a "second identifier", then it is claimed that there is computer code for associating a plurality of patents with "at least one identifier". Appellant seems to argue that each identifier can actually be the same identifier or it may not be? This does not seem to agree with the claim language where it seems that each identifier is separately recited so that the claim requires anywhere from 4 identifiers to an open ended upper limit. The examiner does not see an argument from appellant other than arguing that the claim language is broad, which is not persuasive.

Appellant respectfully disagrees and again notes that in response to the Examiner's question "is the first identifier the same identifier that the notes were stored with?" appellant has responded that it may or may not be and to specify one way or another would be unduly limiting to the claims, since the claim language is purposefully drafted in a broad manner so not to be limited to a scenario where "the first identifier is the same identifier that the notes were stored with."

Additionally, appellant respectfully notes that the pertinent claims clearly require "associating a plurality of patents with the at least one identifier" (emphasis added). Additionally, the claims disclose "a first identifier corresponding to a single patent" as well as "a second identifier corresponding to a group involving a plurality of patents." Therefore, the aforementioned language does not necessarily "requir[e] anywhere from 4 identifiers to an open ended upper limit," as argued by the Examiner.

In the Office Action dated 12/27/2007, the Examiner has argued that appellant's above response is "non-responsive to the question" of "[i]f there is only one file, how can there be a first file and a second file?" Appellant respectfully disagrees and notes that appellant specifically claims "receiving the manual selection of a file," not that "there is only one file," as asserted by the Examiner.

Further, in the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the issue of the file and how many there are, the argument does not seem to be persuasive because all appellant has argued is that the claim language recites "receiving the manual selection of a file" and has argued that it does not recite "only one file" as asserted by the examiner. In response, the claim scope appears to recite one file and then the question is how can there be a 1st and 2nd file if there is only one in the scope of the claim. This issue does not seem to have been addressed by the appellant.

Appellant respectfully disagrees and again points out that appellant specifically claims "receiving the manual selection of a file," where "the manually selected file [is associated] with the at least one identifier," which does not preclude appellant's further language claiming "a manually selected first file... associated with a first identifier corresponding to a single patent, and a manually selected second file... associated with a second identifier corresponding to a group involving a plurality of patents." As a result, there is not a limitation of "only one [file] in the scope of the claim," as argued by the Examiner, since appellant specifically claims "receiving the manual selection of a file," not that "there is only one file," as asserted by the Examiner.

Also, the Examiner has argued the following:

The applicant has a step of ***associating a plurality of patents with the at least one identifier***. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

Thus, how can a plurality of patents be associated with one patent number?

Appellant respectfully asserts that the claims are not limited to "a plurality of patents [being] associated with one patent number," as suggested by the Examiner.

Further still, in the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the issue regarding the associating a plurality of patents with at least one identifier, appellant has stated that the claims do not have a scope that allows for the identifier to be associated with just one patent number. In the Final rejection the examiner of record posed the issue of how the plurality of patents can be associated with one patent number and this issue does not seem to have been specifically argued by appellant. The argument found on page 26 of the response is not quite clear to the instant examiner as it does not seem to address the issue set forth by the examiner in the Final rejection.

Appellant respectfully disagrees. First, appellant has not stated that “the claims do not have a scope that allows for the identifier to be associated with just one patent number,” as argued by the Examiner. Additionally, it appears as though the Examiner has again taken issue with the term “associating” claimed by appellant. Appellant respectfully notes that appellant’s claimed “associating a plurality of patents with the at least one identifier” is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, etc., as argued hereinabove.

Still yet, the Examiner has argued:

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant list the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier. The applicant then adds the language “wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. What does the applicant mean by accessible? It is not clear what applicant is claiming in this step.

In response, appellant relies on the plain and ordinary meaning of “accessible.”

In the Examiner’s Answer dated 08/25/2008, the Examiner has admitted that the rejection regarding “what is meant by ‘accessible’ ... has been withdrawn and overcome in view of the arguments.”

Moreover, the Examiner has argued:

The applicant then has added the language that “wherein a set of patents is *reported* by – what does the applicant mean by “reported”? What set of patents are being reported?

In response, appellant relies on the plain and ordinary meaning of “reported.” Further, the claims have been clarified.

In the Office Action dated 12/27/2007, the Examiner has argued that appellant’s above statement “is non-responsive to the question.” Appellant respectfully disagrees and again notes that appellant relies on the plain and ordinary meaning of “reported.” Further, appellant respectfully notes that appellant specifically claims that “a set of the patents is reported” (emphasis added), in the context claimed by appellant.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

With respect to what is meant by reciting that a set of patents is “reported”, appellant has relied upon the plain and ordinary meaning of this term, but has failed to provide the examiner with any actual definition to consider. What does appellant feel is the plain and ordinary meaning of this term? Appellant has not explained or sufficiently rebutted the position of the examiner to find the argument persuasive.

Appellant respectfully disagrees. First, it appears that the Examiner has taken issue with many terms that may be found in the dictionary. Additionally, appellant again notes that the above claim language is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, etc. For example, an illustrative dictionary definition of “report” is “[t]o make or present an often official, formal, or regular account of” (*The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004).

The Examiner has additionally argued the following:

The applicant then states *displaying a technology mapping depicting one category of technology utilizing a graphical user interface and displaying statistics regarding a number of patents of the set in each category of technology.*

First, applicant only claims one category of technology in the displaying of a technology mapping. Then the applicant claims displaying statistics in each category of technology. How can one category become each category? Where does the technology mapping come from?

Regarding the present inquiry, appellant respectfully asserts that the claims were clarified in the amendment dated 09/21/2007 to avoid this issue. Specifically, appellant clearly claims “displaying a technology mapping depicting a plurality of categories of technology.”

In the Office Action dated 12/27/2007, the Examiner has admitted that “[appellant] has amended the claims to overcome the question of how can one category become each category,” but has again argued “where does the technology mapping come from” and has further argued that “[t]he claim language up until now relates to notes fields and identifiers.” Appellant respectfully disagrees and notes that appellant specifically claims “displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface” (emphasis added), in the context claimed by appellant.

In the Examiner’s Answer dated 08/25/2008, the Examiner has removed the “issue of the ‘technology mapping’ and where the mapping comes from... as it has been overcome.”

The Examiner has also argued:

Applicant then claims displaying first additional information associated with at least a portion of patents of the set in a second interface separate from the first interface upon the selection an positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, the first information including a list of patents of the set associated with one category of technology, displaying a second additional wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, an exemplary figure information; wherein the statistics are displayed in the first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface.

It is not clear how the set of patents being displayed is connected to the identifier or the file. It is unclear to the Examiner what the applicant is claiming in the claim language. **Applicant has started out with a notes field, storing the notes field with an identifier, selecting a file, storing the file, associating a plurality of patents with at least one identifier** (it is not clear where the plurality of patents come from since there is no search being performed), **making the notes and files and patents accessible by selection of the at least one identifier** (however, where is it in the claim language that the notes, files and patents where ever correlated with one identifier). **Applicant then states that a set of patents is reported** (however, it is not clear what set of patents or if the set of patents relate to any of the steps above), **displaying a technology mapping depicting at least one category of technology** (note that the patents are not mentioned in this displaying step), **displaying statistics**

regarding a number of patents of the set in each category (note that now we have more than one category, wherein the step above one requires one category),
displaying additional information in a second interface, wherein the first additional information includes a list of the patents of the set associated with one category of technology (note that now we are back to one category of technology and that the information includes a list of the patents of the set associated with this one category of technology, however there is no earlier correlation with the technology mapping depicting at least one category of technology and a listing of patent),
displaying second information associated with at least one of the patents in the list in a third interface (however, it is unclear where this list even comes from), wherein the second information is selected from the group consisting of a patent number, a status, a claim or a figure. What does this mean? Your first information is information associated with patents and your second information is a patent number, status????).

Appellant respectfully asserts that the claims were clarified in the amendment dated 09/21/2007 to avoid this issue.

In the Office Action dated 12/27/2007, the Examiner has merely "disagree[d] with [appellant's] assertion" but has failed to specifically respond to appellant's arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

In the Examiner's Answer dated 08/25/2008, the Examiner has merely argued that "the appellant has not actually provided any argument for this issue" and that "the argument is not persuasive." Appellant respectfully disagrees and again notes that the claims have been clarified in the amendment dated 09/21/2007 in order to avoid the aforementioned issue.

Further still, the Examiner has argued the following:

The applicant states in the claim language "that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail". This is unclear.

What does the applicant mean by "made accessible?" Are they transmitted?

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary. In response, appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

On page 31 of the Appeal Brief appellant argues that appellant has relied upon the plain and ordinary meaning of this term, but has failed to provide the examiner with any actual definition to consider. What does appellant feel is the plain and ordinary meaning of this term? Appellant has not explained or sufficiently rebutted the position of the examiner to find the argument persuasive.

Appellant respectfully disagrees and again notes that it appears that the Examiner has taken issue with many terms that may be found in the dictionary. Again, appellant notes that the above claim language, including the phrase "made accessible," is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, etc.

Group #2: Claim 5 and 6

With respect to dependent claims 5 and 6, the Examiner has argued the following:

In Claims 5 and 6, it is unclear what the applicant means by the language "the at least one identifier is determined utilizing an add icon" or "a modify icon".

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary. In response, appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

For claims 5 and 6, the argument is not persuasive. The examiner stated that it was not clear as to what is meant by "the at least one identifier is determined utilizing an add icon or a modify icon. The response from appellant is reliance upon the plain and ordinary meaning of certain terms without actually providing any explanation as to what the plain and ordinary meanings actually are. No definitions have been provided so it is not clear what the position of the appellant actually is.

Appellant respectfully disagrees and notes that it again appears that the Examiner has taken issue with many terms that may be found in the dictionary. Additionally, appellant again notes that the above claim language is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, etc.

Group #3: Claim 8 and 9

With respect to dependent claims 8 and 9, the Examiner has argued the following:

In Claims 8 and 9, it is unclear what the applicant means by the file is selected utilizing a file structure field? What is a file structure field? What does the applicant mean by the file structure field includes a file tree structure?

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary. In response,

appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

For claims 8 and 9, the issue set forth by the examiner was what was meant by "a file structure field" and a "file tree structure". In response appellant again argues that they have relied upon the plain and ordinary meaning of certain terms without actually providing any explanation as to what the plain and ordinary meanings actually are. No definitions have been provided so it is not clear what the position of the appellant actually is.

Appellant respectfully disagrees and notes that it again appears that the Examiner has taken issue with many terms that may be found in the dictionary. Additionally, appellant again notes that the above claim language is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, etc.

Group #4: Claim 12

With respect to dependent claims 12, the Examiner has argued the following:

In Claim 12, it is unclear what the applicant means by the patents associated with the at least one identifier are identified by searching a database of already existing identifiers. This is unclear. It is not clear what the applicant is searching or what the applicant is searching for.

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and are not even technical in nature). In response, appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

For claim 12, appellant again argues that they have relied upon the plain and ordinary meaning of certain terms without actually providing any explanation as to what the plain and ordinary meanings actually are. No definitions have been provided so it is not clear what the position of the appellant actually is.

Appellant respectfully disagrees and notes that it again appears that the Examiner has taken issue with many terms that may be found in the dictionary. Additionally, appellant again notes that the above claim language is to be read according to the plain and ordinary meaning thereof, in view of dictionary definitions, etc.

Issue # 3:

The Examiner has rejected Claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Group #1: Claim 20

The Examiner has argued the following:

It is not clear what statutory class applicant is coming in for. A system can be an apparatus, whereby there would need to be some recitation of structure. Applicant identifies the invention as a system comprising a computer readable medium. However, applicant has not claimed the code as being on the medium. Thus, so far, the invention appears to be directed to a system comprising a computer readable medium. It is not clear what applicant identifies as a medium in the specification. Not all computer readable mediums are statutory, ie, signals, carrier waves. Thus, it is unclear what applicant is claiming in claim 20.

Appellant respectfully disagrees and notes that appellant specifically claims "[a] system comprising... a computer readable medium." In addition, appellant respectfully points out, just by way of example, that Figure 2 of appellant's specification as originally filed clearly shows various examples of tangible computer readable media.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

For claim 20, the issue of whether or not the claim scope includes a storage medium such as a signal or a carrier wave has not been addressed by the appellant. Also not addressed was the issue of whether or not the computer code was actually stored on the storage medium. If the computer code is not recited as being stored on the storage medium then what is the system made up of? The examiner can read that the claim recites "a system comprising" and "a computer readable medium", so just repeating what is already known is not addressing the issue at hand.

Appellant respectfully disagrees and again notes that appellant specifically claims "[a] system comprising... a computer readable medium" as well as "computer code," as claimed by appellant. In addition, appellant again respectfully points out, just by way of example, that Figure 2 of

appellant's specification as originally filed clearly shows various examples of tangible computer readable media.

Issue # 4:

The Examiner has rejected Claims 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 2003/0046307) in view of Barnett et al. (U.S. Patent No. 2002/0082778).

Group #1: Claims 1, 8-13, 18-20, and 44-45

The Examiner has relied on the Rivette and Barnett references to make a prior art showing of appellant's following claim language:

“displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology,

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure” (see this or similar, but not necessarily identical language in the independent claims).

First, the Examiner has argued that Figures 111-112 and 117-134 of Rivette meet appellant's claimed “displaying statistics...in a first interface, displaying first additional information in a second

interface..., [and] displaying second additional information in a third interface” (see this or similar, but not necessarily identical language in the independent claims).

Appellant respectfully disagrees and asserts that the description of Figures 111-112 only states that “FIG. 111 is an example display format showing the display of patent text in a first window and notes in a second window” (see Paragraph [0101]), and that “FIG. 112 is an example display format showing the display of patent text in a first window and patent image in a second window” (see Paragraph [0102]). Additionally, Figures 117-134 only disclose “an example console screen shot,” “screen shots for creating a new group,” “screen shots for searching through the databases,” “screen shots for displaying text and images of documents,” and a “screen shot for creating a document note” (Paragraphs [0107]-[0111]), among others.

Clearly, displaying patent text, patent notes, and a patent image, as well as displaying a console screen shot and screen shots for creating a group, searching a database, displaying text and images of documents, and creating a document note, as in Rivette, fails to teach or suggest “displaying statistics...in a first interface” (emphasis added), as appellant claims. In fact, appellant notes that simply nowhere in Figures 111-112 of Rivette is there any showing of any sort of statistics, as appellant claims. Specifically, appellant points out that appellant claims “statistics regarding a number of the patents of the set in each category of technology,” in the context claimed. Figures 111-112 of Rivette only relate to patent text, patent notes, and a patent image associated with a single patent, such that Rivette does not disclose, and would not even suggest “displaying statistics regarding a number of the patents of the set in each category of technology” (emphasis added), as claimed. Similarly, Figures 111-112 of Rivette also does not show “displaying first additional information associated with at least a portion of the patents of the set in a second interface... wherein the first additional information includes a list of the patents of the set associated with one category of technology” (emphasis added), in the context claimed.

Moreover, appellant respectfully points out that on pages 16-17 of the Office Action dated 12/27/2007, the Examiner even admits that “Rivette does not explicitly [disclose]...wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface.” Thus, the

Examiner has expressly acknowledged that Rivette does not disclose appellant's claim language argued above.

Appellant further notes, however, that the Examiner relied on Figures 21-24 of Barnett in arguing that "Barnett discloses... [that] the first additional information includes a list of patents of the set associated with one category of technology, and wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, and wherein the statistics are displayed."

Appellant respectfully asserts that the Examiner's above cited argument fails to even address appellant's claim language admitted by the Examiner to not be met by Rivette, namely "displaying statistics...in a first interface; displaying first additional information in a second interface separate from the first interface..., [and] displaying second additional information in a third interface separate from the first interface and the second interface," as claimed. Thus, appellant respectfully asserts that the Examiner has failed to make any specific prior art showing of appellant's specific claim language.

In the Office Action dated 12/27/2007, the Examiner has merely argued that the newly relied upon Figures 117-134 teach such claim language. Appellant respectfully disagrees for at least the reasons noted above.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

On page 34 of the Appeal Brief, appellant argues the limitation regarding the displaying of statistics in a 1st and 2nd interface as claimed. On the bottom of page 34 it is stated that Rivette discloses the displaying of information in 1st and 2nd windows. As far as the display of information goes, Rivette teaches the use of multiple windows which is seen as satisfying the claimed 1st and 2nd interfaces because the instant specification discloses the use of more than one window, just like the prior art. Regarding the limitation of the display of statistics, the instant examiner sees the kind of data that is displayed as being directed to non-functional descriptive material as this is just the display of a broad recitation to data. The scope of the term "statistics regarding a number of patents" is broad language that can be satisfied by the display of any data regarding a number of patents. The argument that the prior art does not display "statistics" is not persuasive as this term is broad and because the prior art displays information about patents, this is seen as satisfying what is claimed. Patent text, patent notes, and patent images are considered to satisfy what is claimed as this is patent information regarding patents.

Appellant respectfully disagrees and notes that appellant specifically claims "displaying statistics...in a first interface, displaying first additional information in a second interface..., [and] displaying second additional information in a third interface" (see this or similar, but not necessarily identical language in the independent claims), which is not "just the display of a broad recitation to data" or "broad language that can be satisfied by the display of any data regarding a number of patents," as argued by the Examiner.

Additionally, appellant again notes that even the Examiner has admitted that "Rivette does not explicitly disclos[e]...wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface" on Pages 16-17 of the Examiner's Answer dated 08/25/2008. Thus, the Examiner has expressly acknowledged that Rivette does not disclose appellant's claim language argued above.

Additionally, appellant again notes that Figures 111-112 of Rivette only relate to patent text, patent notes, and a patent image associated with a single patent, and that Rivette merely displays a console screen shot and screen shots for creating a group, searching a database, displaying text and images of documents, and creating a document note, which fails to teach or suggest “displaying statistics...in a first interface” (emphasis added), where appellant claims “statistics regarding a number of the patents of the set in each category of technology,” in the specific context claimed by appellant.

The Examiner has also relied on Paragraph [0270] in Rivette to meet appellant’s claimed “drilling down from the first interface to the second interface..., [and] drilling down from the second interface to the third interface” (see this or similar, but not necessarily identical language in the independent claims).

Appellant respectfully asserts that such excerpt from Rivette merely discloses that “[t]he operator may be able to uncover additional useful data by viewing, analyzing, and/or processing these parent and child groups, either with or without the original group.” In addition, appellant notes that Paragraph [0271] in Rivette simply mentions “data drilling.” Thus, it seems the Examiner has failed to consider the full weight of appellant’s claimed limitations.

In particular, as noted above, Rivette only generally teaches viewing, etc. parent and child groups with or without an original group, in addition to data drilling, which fails to specifically disclose “displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology, [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface wherein the second additional information at least one of a patent number, a status, an

exemplary claim, and an exemplary figure” (emphasis added), as claimed. Only appellant claims and teaches drilling down in such a specific manner.

In the Examiner’s Answer dated 08/25/2008, the Examiner has stated the following:

Appellant states that Rivette discloses viewing parent and child groups with or without an original group, in addition to data drilling, but it is not clear as to why the language of Rivette does not satisfy what is claimed. The display of information in interfaces as claimed has already been addressed and as best understood by the examiner, with respect to the drilling down limitation, the prior art satisfies what is claimed.

Appellant respectfully disagrees. First, appellant again notes that as shown above, Rivette fails to disclose “[t]he display of information in interfaces as claimed,” as argued by the Examiner. Further, the Examiner’s arguments that “as best understood by the examiner, with respect to the drilling down limitation, the prior art satisfies what is claimed” and that “it is not clear as to why the language of Rivette does not satisfy what is claimed” fail to address appellant’s arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Furthermore, the Examiner has argued that “Rivette displays interfaces showing different information relating to patents, wherein the interfaces have three interfaces (Figs 57, 125, 117)” to meet appellant’s claimed “displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface” (see this or similar, but not necessarily identical language in the independent claims-emphasis added).

Again, it seems that the Examiner has failed to consider the full weight of appellant's claim language. Appellant respectfully asserts that simply disclosing interfaces showing different patent information, as noted by the Examiner, fails to specifically disclose "displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface" (emphasis added), in the context claimed by appellant. Appellant also respectfully asserts that Figures 57, 125, and 117 from Rivette, as relied on by the Examiner, also fail to disclose such specific claim language.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

As stated previously, applicant's specification discloses the use of separate windows not interfaces, so this extent the prior art satisfies what is claimed because the prior art teaches the use of different windows. As far as the data that is displayed, the prior art is seen as satisfying the data as previously addressed.

Appellant respectfully disagrees. First, it appears that the Examiner is mixing alleged deficiencies under 35 U.S.C. 112, with the current rejection under 35 U.S.C. 103. Additionally, as shown above, appellant clearly claims "displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface" (emphasis added), as claimed, which is clearly supported by appellant's specification.

Further, it appears as though the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Still yet, the Examiner has admitted that Rivette does not explicitly disclose displaying a technology mapping, but has argued that “page 2 [0025] does not exclude technology mapping.” Appellant respectfully asserts that simply because the Rivette reference does not “exclude” something, does not mean it discloses, teaches, or suggests the same.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the technology mapping, the examiner has relied upon Barnett for this limitation and the appellant has only argued that because Rivette does not exclude technology mapping does not mean that it discloses or teaches technology mapping. The secondary reference to Barnett is what was relied upon for a teaching of the technology mapping and applicant has only argued the primary reference, which is not persuasive. There does not appear to be any other discussion or argument concerning this limitation.

Appellant respectfully disagrees and notes that, as shown on Page 16 of the Examiner’s Answer dated 08/25/2008, the Examiner has argued that “Rivette does not explicitly disclos[e] displaying a technology mapping (although page 2 [0025] does not exclude technology mapping),” which clearly references Rivette, contrary to the Examiner’s above assertion. Additionally, appellant points out that Paragraph [0025] of Barnett merely “illustrates how the various aspects of the cell selection score, activity or innovation, concentration or dominance, and predictive activity or innovation can be graphically represented on a bubble chart and interpreted,” which does not disclose “a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface” (emphasis added), in the context claimed by appellant.

Moreover, appellant respectfully asserts that the Examiner has failed to make a specific prior art showing of all of appellant’s claim limitations. For example, the Examiner has failed to make a prior art showing of appellant’s claimed “displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information

includes a list of the patents of the set associated with one of the categories of technology, [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure” (emphasis added), as claimed.

Appellant respectfully asserts that only appellant claims and teaches drilling down based on “selection of an icon positioned in the first interface and associated with one of the statistics,” and drilling down based on “selection of an additional icon positioned in the second interface and associated with one of the patents,” as claimed.

In the Examiner’s Answer dated 08/25/2008, the Examiner has merely argued that the above language “has already been addressed by the examiner.” Appellant respectfully disagrees and additionally notes that the Examiner has failed to respond to appellant’s arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Appellant again emphasizes that many benefits arise from the synergy of the technology mapping, and the remaining claimed framework. Specifically, a user is capable of associating patents with at least one identifier (with additional notes associated therewith), and also obtaining technology-related metrics regarding a set of patents, with one framework that is more effectively organized (see details of claims). Specifically, only appellant teaches and claims such a drill-down technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements.

In the Examiner’s Answer dated 08/25/2008, the Examiner has stated the following:

On page 39 appellant implies that the claimed invention provides some sort of synergistic result; however, the examiner notes that no evidence or explanation of what the synergistic result is has been provided for review. No showing of any "synergistic" result has been made.

Appellant respectfully disagrees and again notes that only appellant teaches and claims the aforementioned drill-down technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements. Additionally, appellant notes that the Examiner has failed to respond to appellant's above arguments with respect to the aforementioned claim language, and as a result, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Additionally, with respect to appellant's independent claims, the Examiner has argued that "these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited," in that the "data does not alter how the system functions or the steps are performed," and the "displaying would be performed the same regardless of the data." The Examiner has therefore concluded that "this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability."

Appellant respectfully disagrees and points out the following from MPEP 2106:

"The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among that data and the computing processes performed when utilizing that data. As such, a claim to that computer is statutory subject matter because it implements a statutory process."

Appellant respectfully emphasizes that appellant claims "displaying statistics... in a first interface" where "first additional information [is displayed]...in a second interface separate from the first

interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface,” as claimed. Clearly, such claim language requires a functional interrelationship, in that first additional information is displayed in a second interface separate from a first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics displayed in the first interface, as claimed. Further, the selection of such icon results in a drilling down from the first interface to the second interface, as claimed.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

On page 39, the issue of certain data in the claims being considered non-functional descriptive material was discussed. Appellant has cited MPEP 2106 with respect to non-functional descriptive material. This section of the MPEP deals with 35 USC 101 issues and is not addressing the issue of claim interpretation for prior art purposes regarding the issue of non-functional descriptive material. The issue in the 35 USC 103 rejection is not dealing with the issue of a statutory claim so appellants argument is not persuasive as it is addressing a 101 issue when the issue at hand is claim interpretation and 35 USC 103.

Appellant respectfully disagrees and notes that the above excerpt from MPEP 2106 concerning “[t]he presence of the claimed nonfunctional descriptive material” (emphasis added) was appropriately cited in response to the Examiner’s argument that “these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited” (emphasis added), as argued by the Examiner. Again, appellant’s claim language requires a functional interrelationship, in that first additional information is displayed in a second interface separate from a first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics displayed in the first interface, as claimed. Further, the selection of such icon results in a drilling down from the first interface to the second interface, as claimed.

Similarly, the abovementioned claim language requires a functional relationship with respect to the third interface, in that second additional information is displayed in a third interface from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, as claimed. Also, the selection of such additional icon result in a drilling down from the second interface to the third interface, as claimed.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

On page 40 appellant argues that the displaying of information in more than one "interface" (really a window) is a functional relationship so the data should not be considered as non-functional. The selection of an icon does not mean that that displayed data is functional; it may very well be non-functional descriptive material that is displayed. Just because one selects an icon to display more data does not automatically render that data as functional. That argument is not persuasive. With respect to the actual data displayed, it is still seen as being directed to non-functional descriptive material as it is just descriptive in nature and merely describes certain patent information. The data stored and displayed by the system is merely stored and retrieved and this does not present a functional relationship between the system and what is displayed. The argument is not persuasive.

Appellant respectfully disagrees. First, appellant again notes that, as shown above, appellant clearly discloses "displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface" (emphasis added), as claimed, which is clearly supported by appellant's specification. Therefore, appellant does not merely claim an interface that is "really a window," as argued by the Examiner.

Further, with respect to the Examiner's remaining arguments that appellant's claimed language "is still seen as being directed to non-functional descriptive material as it is just descriptive in nature and merely describes certain patent information" et al., appellant disagrees and again notes that the abovementioned claim language does in fact require a functional relationship with respect to the third interface, in that second additional information is displayed in a third interface from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, as claimed. Also, the selection of such additional icon result in a drilling down from the second interface to the third interface, as claimed.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

The statement that "wherein the manually entered notes, at least one of the manually selected files and the patents are accessible by subsequent selection of the at least one identifier" does not provide for a positive recitation of accessing the notes, files or patents, not is there a positive recitation of the at least one identifier being selected and thus this language is merely non-functional descriptive data.

Appellant respectfully disagrees and notes that appellant specifically claims a technique "wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier" (emphasis added), as claimed.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the issue of the files and patents being accessible by selection of an identifier, appellant seems to argue that this step is required in the claim. The examiner disagrees. The term "accessible" means that the files and patents are able to be accessed, nothing more. This is not a recitation to a step of actually accessing the files and patents. Appellant is only reciting the ability for the files and patents to be accessed, not an actual step of accessing them. Additionally, the instant examiner sees this as a moot point anyway because the prior art clearly teaches that the files and patents can be accessed by a user. The argument is not persuasive.

Appellant respectfully disagrees and again notes that appellant specifically claims a technique "wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier" (emphasis added), as claimed.

Additionally, in the Office Action dated 12/27/2007, the Examiner has argued the following:

The recitation of "wherein the notes field allows a user to cut and paste notes" is only descriptive of the notes field. There is no positive recitation of the user cutting and pasting notes in the notes field.

Appellant respectfully disagrees and notes that appellant specifically claims a technique "wherein the notes field allows a user to cut and paste notes" (emphasis added), as claimed.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the user being able to cut and paste in the notes field, this is another limitation directed to the ability for something to happen and is not a recitation to the actual act occurring. Allowing something to happen is not the same as that something actually happening, there is a difference. The argument is not persuasive.

Appellant respectfully disagrees and again notes that appellant specifically claims a technique “wherein the notes field allows a user to cut and paste notes” (emphasis added), as claimed.

Further, in the Office Action dated 12/27/2007, the Examiner has argued the following:

The recitation “wherein the file is selected utilizing a file structure field including a file tree structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents” does not provide a positive recitation of a file being selected. The fact that the file structure field includes a file tree structure is non-functional descriptive data. The fact that the file tree structure allows a user to browse various folders is not a positive recitation of folders actually being browsed. There is no positive recitation of displaying the file structure simultaneously with the notes field. Moreover, the fact that the file tree structure includes information from a source separate from the patents is non-functional descriptive data.

Appellant respectfully disagrees and notes that appellant specifically claims a technique “wherein the file is selected” (emphasis added), and further claims that “the file structure is displayed” (emphasis added), as claimed.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the file structure field and the file tree structure, the argument is not persuasive. The prior art is seen as satisfying this limitation. The only thing claimed is the selection of a file and the language about the user browsing, etc., is not seen as positively being claimed. As stated previously to allow something to occur is not the same as that something actually occurring.

Appellant respectfully disagrees and again notes that appellant specifically claims a technique “wherein the file is selected” (emphasis added), and further claims that “the file structure is displayed” (emphasis added), as claimed.

Further still, in the Office Action dated 12/27/2007, the Examiner has argued the following:

As for the limitation of “wherein the patents associated with the at least one identifier are identified by searching a database including a comprehensive database of all patents issued by at least one government agency is non-functional descriptive data.

Appellant respectfully disagrees and notes that appellant specifically claims “searching a database including a comprehensive database of all patents issued by at least one government agency” (emphasis added), as claimed.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the database being recited as “issued by at least one government agency”, this is directed to non-functional descriptive material as it does not matter who issued the database. All that matters is that a database is searched, the entity that issue the database or created it is language directed to non-functional descriptive material.

Appellant respectfully disagrees. Additionally, appellant notes that the Examiner has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Also, in the Office Action dated 12/27/2007, the Examiner has argued the following:

As for the limitation "wherein a set of the patents is reported by:

displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,

displaying statistics regarding a number of patents of the set in each of the categories of technology in a first interface;

displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the additional information includes a list of patents of the set associated with the one of the categories of technology;

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim and an exemplary figure" the Examiner asserts the following:

All that the is required by the claim limitations is displaying a technology mapping depicting a plurality of categories of technology, displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface”.

Appellant respectfully disagrees and notes that appellant’s claimed language is to be read as claimed, and thus clearly is not limited to “displaying a technology mapping depicting a plurality of categories of technology, displaying statistics regarding a number of the patent of the set in each of the categories of technology in a first interface,” as suggested by the Examiner.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

On the bottom of page 42 to the middle of page 43 of the Appeal Brief, appellant cites a portion of the action that the examiner wrote and then simply states that the language should be read as recited and is not limited to displaying a technology mapping.... and displaying statistics..” as suggested by the examiner. It is not clear as to what this argument is trying to convey. It does not seem to be explained why the prior art does not disclose what is claimed.

Appellant respectfully disagrees and again notes that the aforementioned claimed language is to be read as claimed, and thus clearly is not limited to “displaying a technology mapping depicting a plurality of categories of technology, displaying statistics regarding a number of the patent of the set in each of the categories of technology in a first interface,” as suggested by the Examiner.

In addition, in the Office Action dated 12/27/2007, the Examiner has argued the following:

Moreover, many of the differences between the prior art and applicant’s claimed invention are deemed to be non-functional descriptive data.

Appellant respectfully disagrees, and refers the Examiner to the above arguments.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the argument on pages 43-44 and the issue of the data being displayed being considered as non-functional, this has already been addressed and is found non-persuasive as previously set forth. The limitation regarding the displaying of statistics on 1st,2nd,3rd interfaces has already been addressed and is essentially a repeat of a previously made argument.

Again, appellant respectfully disagrees, and refers the Examiner to the above arguments.

The Examiner has also argued the following:

The Examiner asserts that the data identifying what is displayed in the record adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying what is in the record does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Appellant respectfully disagrees and notes that, as shown above, appellant's aforementioned claimed language does not constitute nonfunctional descriptive material. Appellant again emphasizes that appellant claims "displaying statistics... in a first interface" where "first additional information [is

displayed]...in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface,” as claimed. Clearly, such claim language requires a functional interrelationship, in that first additional information is displayed in a second interface separate from a first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics displayed in the first interface, as claimed. Further, the selection of such icon results in a drilling down from the first interface to the second interface, as claimed.

Again, the abovementioned claim language requires a functional relationship with respect to the third interface, in that second additional information is displayed in a third interface from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, as claimed. Also, the selection of such additional icon results in a drilling down from the second interface to the third interface, as claimed.

The Examiner has further argued that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.”

In view of the above argument made by the Examiner, it seems the Examiner has simply dismissed the appellant’s claim limitations under Official Notice. In response, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish the Rivette and Barnett references. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the appellant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

On page 45 of the Appeal Brief the appellant argues that the examiner has incorrectly taken "official notice" and requests a citation of a reference. The instant examiner has reviewed the Final rejection and does not see where any official notice was taken on the record with respect to the issue of the type of data being displayed as being obvious. The argument is not persuasive. Additionally, because the data that is recited as being displayed regarding patents is directed to non-functional descriptive material, it follows that when one is dealing with patents, one of ordinary skill in the art can select and choose what the data is that is to be displayed and this amounts to a nothing more than a selection of what kind of non-functional descriptive material is to be displayed.

Appellant respectfully disagrees and points out the above argument argued by the Examiner on Page 21, first paragraph of the Office Action dated 12/27/2007. Additionally, appellant refers the Examiner to the above arguments that clearly address the Examiner's arguments of non-functionality.

Furthermore, in the Office Action dated 12/27/2007, the Examiner has argued the following:

Furthermore, applicant's disclosure states that the summary report 1500 may be generated in any desired manner and the details of report 1600 may be generated in any desired manner (page 32, lines 14-15 and page 33, line 15).

Thus, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to display the report as Rivette and Barnett have since applicant has not disclosed that displaying the

report as applicant now claims provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected applicant's invention to perform equally well with the reports and the details of the reports being generated in any desired manner, as set forth by application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the reports and the details of the reports in any desired manner since, as applicant admits above, there is no advantage, particular purpose, or solution to a problem being solved.

In view of the above argument made by the Examiner, it seems the Examiner has simply dismissed the appellant's claim limitations under Official Notice. In response, appellant respectfully disagrees and notes that the language of each of appellant's independent claims specifically discloses the way in which a set of the patents is reported, as claimed, and not that the set of patents may be reported "in any desired manner," as suggested by the Examiner. Additionally, appellant notes that appellant has not admitted that "there is no advantage, particular purpose, or solution to a problem being solved" in appellant's claimed language, as asserted by the Examiner. In fact, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish the Rivette and Barnett references. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to pages 45-46 of the Appeal Brief and with respect to the issue of the manner by which a report is displayed, the examiner stated that it would have been obvious to display the report as is done in the prior art because the appellant has not disclosed that displaying the report in the manner claimed is solving any particular problem or produces any unexpected result. In response the appellant argues that the examiner has incorrectly taken "official notice" and that the examiner has not considered all claimed limitations. The instant examiner disagrees and does not see where the examiner has taken official notice in the Final rejection and does not see why the prior art rejection is in error with respect to this issue. What is the criticality of what is claimed?

Appellant respectfully disagrees. First, appellant directs the Examiner's attention to the above argument argued by the Examiner on Page 21, last paragraph, to Page 22, first paragraph, of the Office Action dated 12/27/2007. Additionally, appellant again notes that the language of each of appellant's independent claims specifically discloses the way in which a set of the patents is reported, as claimed. Further, appellant again points out the remarks above that clearly show the manner in which some of such claims are further distinguished from the Rivette and Barnett references.

The Examiner has additionally argued that the "fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known." Specifically, the Examiner has argued that "it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize e-mail as a way of communication."

Appellant respectfully disagrees and points out that appellant specifically claims a technique "wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail," as claimed. Appellant respectfully asserts that simply alleging that e-mail is well known, as noted by the Examiner, fails to consider the full weight of appellant's claimed limitation, namely that "the notes and at least one of the files are made accessible to other parties utilizing e-mail" (emphasis added), as claimed.

Still yet, the Examiner has argued that “because of the way [the aforementioned claim language] is worded, it could encompass a person e-mailing another person to come look at the notes and files.” Appellant disagrees and respectfully asserts that appellant’s claims that “the notes and at least one of the files are made accessible... utilizing e-mail” (emphasis added), as claimed. Clearly, making notes and at least one file accessible utilizing e-mail, as claimed, does not simply “encompass a person e-mailing another person to come look at the notes and files,” as noted by the Examiner. In particular, in the situation where a person e-mails another person to come look at the notes and files, as suggested by the Examiner, requires the person to personally make the notes and files accessible to the other person.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

A “traverse” is a denial of an opposing party’s allegations of fact.³ The Examiner respectfully submits that applicants’ arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants’ arguments and comments as

constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971). If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following are admitted prior art:

wherein notes and files are made accessible to other parties utilizing e-mail.

Appellant respectfully disagrees and again points out that simply alleging that e-mail is well known, as noted by the Examiner, fails to consider the full weight of appellant's claimed limitation, namely that "the notes and at least one of the files are made accessible to other parties utilizing e-mail" (emphasis added), as claimed.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to the use of email and the limitation regarding that the files are accessible by email, the argument is not persuasive. What is claimed is simply the use of email, which is something that is very well known to one of ordinary skill in the art. To simply recite that files and patents are accessible (able to be accessed) by email is just reciting that ability for those files to be sent by email. To start with, the files and patents of the prior art are accessible so that part of the language is satisfied. To minor difference of using email is something that involves no more than ordinary skill in the art and is well within the knowledge of one of ordinary skill in the art. With respect to the argument that making files and patents accessible by email does not allow for the files and patents to be sent by email, this is not persuasive. One way to make the files and patents accessible to another is to email them by using email. This situation satisfies what is claimed.

Appellant respectfully disagrees and again notes that appellant specifically claims a technique “wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail,” as claimed, and not “simply the use of email,” “using email,” or “that ability for those files to be sent by email,” as argued by the Examiner. Additionally, appellant notes that appellant has not stated that “making files and patents accessible by email does not allow for the files and patents to be sent by email,” as argued by the Examiner. Again, simply alleging that e-mail is well known, as noted by the Examiner, fails to consider the full weight of appellant’s claimed limitation, namely that “the notes and at least one of the files are made accessible to other parties utilizing e-mail” (emphasis added), as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art and not based on appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #2: Claim 2

With respect to Claim 2, the Examiner has relied on Figure 147 and Paragraphs [0117]-[0120] and [0133]-[0134] in Rivette to make a prior art showing of appellant's claimed technique "wherein the at least one identifier is determined by selecting an already-existing identifier."

Appellant respectfully asserts that Figure 147 in Rivette merely relates to a list of patents in a repository, which clearly does not even suggest that "the at least one identifier is determined by selecting an already-existing identifier," particularly where "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed (see independent claim for context).

In addition, Paragraphs [0117]-[0120] and [0133]-[0134] in Rivette simply disclose an "example console screen shot," "an example screen shot for creating a group note," "example tools bars from the console screen display," "a stacked folder icon used to represent shared groups," and "an example console used to describe shared groups." Clearly, none of such excerpts specifically disclose the "the at least one identifier," as appellant claims, in which "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed. In view of the absence of appellant's claimed "at least one identifier" in such experts, such excerpts simply do not more specifically disclose that "the at least one identifier is determined by selecting an already-existing identifier," as claimed.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

For claim 2, the argument is not persuasive. Appellant has argued that figure 147 of Rivette does not show what is claimed, which is wherein at least one identifier is determined by selecting another existing identifier. The "existing identifier" can be interpreted to be the selection of any identifier, which upon selection determines what is to be displayed (which includes notes, etc.). This is what is shown in figure 147 and seems to satisfy what is claimed. Also, with respect to claim 2 this is not even a method claim so arguing the manner by which an identifier is selected is not seen as receiving much weight as claim 2 is directed to the computer program product, not a method.

Appellant respectfully disagrees and notes that appellant specifically claims a technique "wherein the at least one identifier is determined by selecting an already-existing identifier," and not a technique "wherein at least one identifier determined by selecting another existing identifier" (emphasis added), as argued by the Examiner. Additionally, appellant's claimed language, in the specific context claimed by appellant, clearly does not merely disclose "the selection of any identifier, which upon selection determines what is to be displayed," as argued by the Examiner.

More specifically, as claimed by appellant, "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed (see Claim 1). Therefore, Figure 147 in Rivette merely relates to a list of patents in a repository, which clearly does not even suggest that "the at least one identifier is determined by selecting an already-existing identifier," in the context specifically claimed by appellant. Further, appellant respectfully disagrees with the Examiner's assertion that "arguing the manner by which an identifier is selected is not seen as receiving much weight."

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #3: Claim 4

With respect to Claim 4, the Examiner has relied on Official Notice in rejecting appellant's claimed technique "wherein the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu." Specifically, the Examiner has argued that it is obvious because, for example, "while doing a search in East, the Examiner may use a number from a pull down menu to select a search and then store this search as a new search." In addition, the Examiner has argued that "it would have been obvious...to incorporate a pull-down menu...so as to allow for easy access to the identifiers."

Appellant respectfully disagrees and asserts that, as noted above with respect to the independent claims, Rivette fails to even suggest that "the at least one identifier is determined by selecting an already-existing identifier," in the context claimed, such that it would not have been obvious for "the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu," as suggested by the Examiner. In fact, appellant respectfully asserts that simply using a number from a pull down menu to select a search and then storing the search as a new search, as noted by the Examiner, does not even relate to appellant's claimed "identifier" in which "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed (see independent claim for context).

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Rivette. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

**In view of applicant's failure to adequately
traverse official notice, the following are admitted prior art:**

**wherein the at least one identifier is determined by selecting an already
existing identifier utilizing a pull-down menu.**

Appellant respectfully disagrees and again notes that Rivette fails to even suggest that “the at least one identifier is determined by selecting an already-existing identifier,” in the context claimed, such that it would not have been obvious for “the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu,” as suggested by the Examiner. In fact, appellant respectfully asserts that simply using a number from a pull down menu to select a search and then storing the search as a new search, as noted by the Examiner, does not even relate to appellant’s claimed “identifier” in which “manually entered notes [are associated] with the at least one identifier” and “a plurality of patents [are] associated with the at least one identifier,” in the context claimed (see independent claim for context). Therefore, appellant has set forth an adequate traverse, and formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Examiner’s Answer dated 08/25/2008, the Examiner has argued the following:

With respect to claim 4, appellant has relied upon the argument that Rivette does not disclose the selection of an identifier by selecting an already existing identifier. The examiner believes that the issue with respect to claim 4 was relating to the use of a pull down menu and this individual aspect does not seem to have been argued by appellant. If the limitation of the selection of an identifier is in the prior art, then why is the use of pull down menus to aid in the selection not obvious to one of ordinary skill in the art? The use of pull down menus is very well known in the art.

Appellant respectfully disagrees and notes that appellant specifically claims a technique “wherein the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu” (emphasis added), as claimed. As a result, appellant’s claimed language does not merely “relat[e] to the use of a pull down menu,” as argued by the Examiner.

Additionally, appellant again asserts that, as noted above with respect to the independent claims, Rivette fails to even suggest that “the at least one identifier is determined by selecting an already-existing identifier,” in the context claimed, such that it would not have been obvious for “the at least one identifier [to be] determined by selecting an already-existing identifier utilizing a pull-down

menu,” as suggested by the Examiner. Additionally, the failure of Rivette to disclose appellant’s claimed language, as noted above, further fails to suggest that “the limitation of the selection of an identifier is in the prior art,” as argued by the Examiner.

Again, appellant respectfully asserts that simply using a number from a pull down menu to select a search and then storing the search as a new search, as noted by the Examiner, does not even relate to appellant’s claimed “identifier” in which “manually entered notes [are associated] with the at least one identifier” and “a plurality of patents [are] associated with the at least one identifier,” in the context claimed (see independent claim for context).

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #4: Claim 5

With respect to Claim 5, the Examiner has relied on Official Notice in rejecting appellant’s claimed technique “wherein the at least one identifier is determined utilizing an add icon.” Specifically, the Examiner has argued that “[i]t is old and well known to add a file and thus create a new file with a new identifier.” In addition, the Examiner has argued that “it would have been obvious...to incorporate...an add icon...so as to allow for easy access to the identifiers.”

Appellant respectfully disagrees and again asserts that, as noted above with respect to the independent claims, Rivette fails to even suggest “the at least one identifier” in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing an add icon, in the context claimed.

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Rivette. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

**In view of applicant's failure to adequately
traverse official notice, the following are admitted prior art:
wherein the at least one identifier is determined utilizing an add icon**

Appellant respectfully disagrees and again notes that Rivette fails to even suggest "the at least one identifier" in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing an add icon, in the context claimed. Therefore, appellant has set forth an adequate traverse, and formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

For claims 5,6, with respect to the "add icon" and the "modify icon", appellant has argued that Rivette does not disclose the "at least one identifier" in the context claimed. This is not persuasive. Appellant seems to argue that because the identifier is not in the prior art then the issue of the add icon cannot be obvious. This does not seem to be addressing the issue of whether or not it is obvious to use an add icon.

Appellant respectfully disagrees and notes that appellant specifically claims a technique "wherein the at least one identifier is determined utilizing an add icon" (emphasis added), as claimed. Therefore, as noted above with respect to the independent claims, Rivette fails to even suggest "the at least one identifier" in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing an add icon, in the context claimed.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #5: Claim 6

With respect to Claim 6, the Examiner has relied on Official Notice in rejecting appellant's claimed technique "wherein the at least one identifier is determined utilizing a modify icon." Specifically, the Examiner has argued that "[i]t is old and well known to...modify the name of a file thus creating a new identifier." In addition, the Examiner has argued that "it would have been obvious...to incorporate...a modify icon...so as to allow for easy access to the identifiers."

Appellant respectfully disagrees and again asserts that, as noted above with respect to the independent claims, Rivette fails to even suggest "the at least one identifier" in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing a modify icon, in the context claimed.

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Rivette. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

**In view of applicant's failure to adequately
traverse official notice, the following are admitted prior art:
wherein the at least one identifier is determined utilizing a modify icon**

Appellant respectfully disagrees and again notes that Rivette fails to even suggest "the at least one identifier" in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing a modify icon, in the context claimed. Therefore, appellant has set forth an adequate traverse, and formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

For claims 5,6, with respect to the "add icon" and the "modify icon", appellant has argued that Rivette does not disclose the "at least one identifier" in the context claimed. This is not persuasive. Appellant seems to argue that because the identifier is not in the prior art then the issue of the add icon cannot be obvious. This does not seem to be addressing the issue of whether or not it is obvious to use an add icon.

Appellant respectfully disagrees and notes that appellant specifically claims a technique "wherein the at least one identifier is determined utilizing a modify icon" (emphasis added), as claimed. Therefore, as noted above with respect to the independent claims, Rivette fails to even suggest "the at least one identifier" in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing a modify icon, in the context claimed.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #6: Claim 7

With respect to Claim 7, the Examiner has relied on Figure 58 and item 13706 from Figure 137 in Rivette to make a prior art showing of appellant's claimed technique "wherein the notes field allows a user to cut and paste notes."

Appellant respectfully asserts that Figure 58 from Rivette merely shows the tool bar described with respect to Figure 137. However, appellant respectfully asserts that the description of item 13706 in Figure 137, as relied on by the Examiner, only discloses that "[a]n operator presses a Delete The Selected Group Or Patent Note button 13706 in order to delete the note selected in the Notes window 11708" (see Paragraph [1173]-emphasis added). Clearly, deleting a group or patent, as in Rivette, fails to meet appellant's claimed "notes field [that] allows a user to cut and paste notes" (emphasis added), as claimed.

In the Examiner's Answer dated 08/25/2008, the Examiner has argued the following:

With respect to claim 7, all that is recited is that the notes field allows for one to cut and paste notes. Cutting and pasting is a very basic concept to word processing and the prior art satisfies what is claimed. The fact that the prior art has a note field satisfies what is claimed because if one wanted to they could cut and paste from the notes field into Microsoft Word™. Nothing in the prior art would stop someone from using a word processing program to cut and paste from the notes field. Appellant has only recited the ability to do this in the notes field and this is a very basic thing in word processing and the prior art has the ability to do what is claimed. As stated previously, appellant has not actually recited cutting and pasting, just the ability to cut and paste, there is a difference between the two.

Appellant respectfully disagrees. First, appellant clearly claims a technique “wherein the notes field allows a user to cut and paste notes” (emphasis added), as claimed. Further, it appears that the Examiner has relied on Microsoft Word™, which constitutes a reference separate from those in the relevant rejection under 35 U.S.C. 103(a). Further, it is noted that the Examiner has failed to cite specific motivation in the relevant reference(s) to support the case for combining the Microsoft Word™ reference. The Examiner is reminded that the Federal Circuit requires that there must be some logical reason apparent from the evidence of record that would justify the combination or modification of references. In re Regel, 188 USPQ 132 (CCPA 1975). Thus, the reliance on the Microsoft Word™ reference, on its face, is clearly improper.

Further still, appellant again notes that the excerpts from Rivette relied on by the Examiner merely disclose that “[a]n operator presses a Delete The Selected Group Or Patent Note button 13706 in order to delete the note selected in the Notes window 11708” (see Paragraph [1173] - emphasis added). Again, deleting a group or patent, as in Rivette, fails to meet appellant’s claimed “notes field [that] allows a user to cut and paste notes” (emphasis added), as claimed.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

Respectfully submitted,

By: /KEVINZILKA/ Date: October 27, 2008
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